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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,846	04/12/2000	Jeremy Rosenberg	14688-504	6270

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EXAMINER

CHANG, SABRINA A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/547,846

Applicant(s)

ROSENBERG, JEREMY

Examiner

Sabrina Chang

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1-8, 10-16 are rejected under 35 U.S.C. 102(a) as being anticipated by the system "SonicBox" as described by the articles "Sonicbox brings Net radio into your living room" (Partyka, Jeff. October 12, 1999. CNN.com), "Internet Radio Listeners Unchained From Their PCs" (Olenick, Doug. October 25, 1999. Twice Computer Technology), and "Sonicbox and Microsoft Windows Media Internet Radio to the home Stereo" (Dec. 7, 1999. Microsoft Press Release).

Sonicbox is a product designed to capitalize on Internet radio broadcasts. A consumer plugs the Sonicbox Tuner system into his/her broadband Internet connection. The base station translates Internet radio transmissions into wireless signals for broadcast to a remote tuner [Partyka] (receiving at each remote device a message broadcast from the fulfillment system without consumer interaction wherein the broadcast message is transmitted from a fulfillment system to the remote devices using a first transmission medium – wireless connectivity - the message identifying an item available for delivery in electronic form by consumer interaction with the broadcast message, wherein the

Art Unit: 3625

broadcast message is transmitted from a fulfillment system to the remote devices using a first transmission medium, presenting information about the item identified in the broadcast message to the consumers).

When a consumer hears a song on the tuner from an album that they wish to purchase, they press the “tell me more” button on their wireless receiver. A signal is sent back through the PC to the Internet Radio station and the purchase is automatically completed using address and credit card information already downloaded to Sonicbox [Olenick] (receiving at a particular one of the remote devices associated with one of the consumers an instruction generated by the consumer’s interaction with the broadcast message wherein the instruction indicates the consumer’s request to obtain the item available for delivery in electronic form, transmitting information from the particular remote device to the fulfillment system wherein the transmitted information reflects the received instruction, maintaining at the fulfillment system a memory containing information associating each remote device with a consumer). The purchasing function can be used to buy single MP3 files or entire CDs [Partyka] (purchasing of MP3s inherently comprises the delivery of the item electronically via the Internet – i.e. the delivery transmission medium is different from the broadcasting transmission medium, also the ability to delivery MP3s and/or CDs inherently comprises the storage of multiple “addresses” assigned across different “transmission mediums”).

The SonicBox system also allows users to customize the content they receive, including not only music but advertisements, depending on which of several privacy levels they have chosen [Partyka].

Art Unit: 3625

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the system "SonicBox" as described by the articles "Sonicbox brings Net radio into your living room" (Partyka, Jeff. October 12, 1999. CNN.com), "Internet Radio Listeners Unchained From Their PCs" (Olenick, Doug. October 25, 1999. Twice Computer Technology), and "Sonicbox and Microsoft Windows Media Internet Radio to the home Stereo" (Dec. 7, 1999. Microsoft Press Release), as applied in claims 1 and 10.

SonicBox does not explicitly disclose:

- That the remote device maintains a set of previously broadcasted messages for a predetermined period of time
- That the remote device is a set-top box

In that the system does provide for user customization of content, it would have therefore been obvious to one skilled at the time that the system also maintain a set of previously broadcasted messages for a predetermined period of time, according to user preferences, in order to ensure that he/she does not miss out on an appealing purchasing opportunity.

With respect to claim 18, the particular device used to broadcast a message could have been one of any number. It would have been obvious to one skilled in the art at the

Art Unit: 3625

time to modify the system of SonicBox to operate using Internet Radio, Cable, or any type of broadcasting medium in order to broaden the spectrum of reachable users.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sweeney discusses Interactive Television . The article mentions the possibility of a customer purchasing, through their TV, a product related to a particular broadcast they are watching at the time. The article does not however discuss this invention with any particularity.

Bernotas discloses a system where a user can watch a TV broadcast and access, simultaneously, information related to the show via an Internet website. The article does not explicitly disclose that the broadcast incorporates a message that allows the user to purchase desired items.

Decinque discloses an Internet-based video ordering system and method. It does not explicitly disclose that the user purchases a digital product by responding to a broadcast message, sent by a fulfillment center.

King discloses two services, "Buzzhits" and "\*CD". When a user listening to the radio hears a song of interest, they call either of these services and are able to purchase that song or the album. These services do not explicitly comprise a broadcast message that contains information that a user is readily able to respond to.

Fritsch disclose a system and method permitting the purchase of audio music files over the Internet. Fritsch does not explicitly disclose that the purchasing process is

Art Unit: 3625

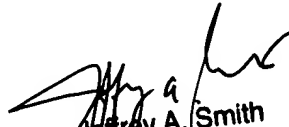
initiated by the fulfillment center – instead the consumer has to actively browse/search for a desired item.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC

  
Jeffrey A. Smith  
Primary Examiner